

Filed by: Fred E. McKelvey
Senior Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-308-7953

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JOHN FELEGI, Jr., and KENNETH P. KEHRER
Junior Party,

v.

ROBERT S. BEYERSDORF and WILLIAM H. KESKEY
Senior Party.

Patent Interference No. 103,626

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent, count, and claims designated to correspond to the count appear in an "Attachment" to this order.

Judge designated to handle the interference

Senior Administrative Patent Judge Fred E. McKelvey has been designated to handle the interference. 37 CFR § 1.610.

MAILED

JUN 21 1996

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Telephone Conference Calls

Any questions regarding this interference may be made to my office via conference call (703-308-9797) in which counsel for all parties must participate. It is not my practice to accept telephone calls from one counsel--even on so-called procedural matters.

Conference calls may be arranged through one of the three Administrators who work at the Board of Patent Appeals and Interferences (hereinafter referred to as the "Board"). Those individuals are (1) Merrell C. Cashion, Jr., (2) Amalia Santiago, and (3) Dale M. Shaw. They can be reached at 703-308-9797.

Counsel for the parties are advised that I am normally scheduled to work in the office on Tuesdays and Wednesdays and that I am readily available for conference calls. Moreover, on days on which I am not scheduled to be in the office, counsel should feel free to contact an Administrator. I am generally available and a conference call can normally be arranged.

Delivery of papers to the Patent and Trademark Office

The parties may use the U.S. Postal Service to send papers and other materials related to this interference to the Patent and Trademark Office. When using the U.S. Postal Service, please use the following address:

BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231.

The parties may also hand deliver papers and other material to the Patent and Trademark Office. When hand-delivery is used,

and when practical for the parties, I would encourage delivery directly to the Board at the following location:

Board of Patent Appeals and Interferences
Crystal Gateway 2
1225 Jefferson Davis Highway
10th Floor
Arlington, Virginia 22202

An appropriate address to use in the case of a commercial one-day delivery service (i.e., Federal Express) is the Board Crystal Gateway address.

Hand-delivery directly to the Board will (1) minimize the time it takes for a paper or other material to reach me and (2) allow me to render prompt decisions on matters presented to me.

The parties may also forward relatively short papers to the Board via fax at 703-308-7953. If a paper is forwarded by fax, it is not necessary to file a confirmation copy.

Requirement for filing two copies of each paper

When presenting a paper in this interference, each party is required to submit (1) an original and (2) one copy of each paper, the copy shall be marked at the top:

"COPY FOR THE SENIOR JUDGE"

Notice under 35 U.S.C. § 135(c)

Notice is hereby given of the requirement of 35 U.S.C. § 135(c) for filing in the U.S. Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference."

Lead and backup counsel

On or before July 12, 1996, each party is required to identify in a separate paper a lead counsel and a backup counsel for lead counsel, as well as the mailing address, telephone numbers and facsimile (fax) number for both lead counsel and backup counsel (37 CFR § 1.613(a)). If counsel's address is a Post Office Box, please supply a non-postal box address where Federal Express may be sent by opposing counsel and/or the Patent Office.

Lead counsel and/or backup counsel should file a power of attorney in their client's application or patent files if not already of record under 37 CFR § 1.34(b).

Notification of entry of orders via the internet

Although all orders entered in this interference are sent to counsel in paper form via mail, fax or Federal Express (as appropriate), I am also willing to forward copies of orders via the internet.

Counsel wishing to receive copies of orders via the internet may supply an E-Mail address as part of the paper identifying lead and backup lead counsel.

I have found that documents formatted in WordPerfect 5.1 (DOS) can be attached to an E-Mail message and downloaded when sent via the internet. An attachment document would be sent via the internet at the same time the paper copy of the document is placed in the Board's outgoing mail box.

Real party in interest

On or before July 12, 1996, each party shall notify the Board in a separate paper of any and all right, title, and interest in any application or patent involved in the interference (37 CFR § 1.602(a)).

All parties are obligated to continually and promptly update changes of the real party in interest.

Size of paper

All papers (e.g., identification of lead counsel, identification of real party in interest, motions, preliminary motions, preliminary statements, briefs, etc.) filed in this interference shall be on 8½ x 11 paper (with the possible exception of original exhibits); papers of a different size (e.g., A4 or legal size) shall not be filed.

Holes at the top of papers

All papers filed in this interference shall have two holes punched at the top spaced at 2-3/4 inches apart (each hole spaced equidistant from an imaginary center line running from the top to the bottom of the paper) so that the papers may be placed in interference files maintained by the Patent and Trademark Office.

Prohibition against presenting duplicate papers

When presenting a paper in this interference, counsel shall not submit with the paper (as an appendix, exhibit, or otherwise) a copy of a paper previously filed in the interference (37 CFR § 1.618(b)).

Citation of case law in papers

When citing a decision of a court which is published in the West Reporter System and the USPQ, counsel should provide parallel citations, e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992).

Copies of file wrappers to opponents

The parties to the interference have access to the files involved in the interference and to benefit files. 37 CFR § 1.612(a). On or before July 12, 1996 of the date of this order each party shall notify the Board in a paper that it has ordered a copy of the opponents' application and/or patent files. A copy of the order for files must be attached to the "paper."

The copy center formerly located at the Board of Patent Appeals and Interferences is closed. Copies of files may be ordered at the following location:

Certification Division
North Towers
10th Floor
Room 10-C-13
Arlington, Virginia
703-308-9726

See also Notice of the Acting Chief Administrative Patent Judge Bruce H. Stoner, Jr., Availability of Interference Files and Interference Related Application and Patent Files, 1184 Off. Gaz. Pat. Office 15 (Mar. 5, 1996).

Service of papers by hand or Express Mail

All papers served on opposing counsel in this interference shall be served by Express Mail (a one-day delivery service of the U.S. Postal Service) (37 CFR § 1.646(d)); alternatively counsel may serve opposing counsel using any means which accomplishes a one-day delivery, e.g., by hand, fax, or a commercial one-day delivery service.

Conference call to set dates

When proceedings are concluded on proceedings for summary judgment (see Paper No. 2 entered concurrently herewith), a telephone conference call to set dates for filing preliminary statements and preliminary motions and for taking such other action as may be appropriate will be scheduled.

A copy of a "sample" order relating to the filing of preliminary motions (and related materials) and preliminary statements accompanies this notice. Counsel are encouraged to discuss the order by phone prior to the telephone conference call.

Headings to be used on papers filed in the interference

In all papers filed with the Board in this interference on behalf of a party, the heading shown in the attached Appendix shall be used.

Notification to the Board of receipt of this notice

Counsel for each party is requested to promptly advise me by letter that the notice declaring the interference was received.

Copies of patents and literature mentioned in each specification (and translations, if available)

On or before August 1, 1996, each party:

(1) shall serve on all opponents a legible copy of every patent and literature reference (and in the case of patents or literature in a foreign language, a translation, if available) mentioned in the specification of the party's involved patent and/or application, and

(2) shall file in the Patent and Trademark Office a notice (without copies of the patents or literature) that it has served the patents and literature as ordered herein.

Copy of specification/claims in electronic form

On or before August 1, 1996, each party is requested to file with the judge assigned to this interference a computer floppy disk (preferably a 3½" high density disk, but 5¼" is acceptable) containing in a first document on the disk a copy of the party's specification and in a second document on the disk a clean copy of the party's claims as currently worded (for use in an IBM compatible computer in WordPerfect 5.1 for DOS, Microsoft Word 6.0 for Windows, or ASCII format (preferably WordPerfect 5.1 for DOS)).

Comments on requests for extensions of time

The parties are advised that I set times with the view to rendering prompt and timely decisions. Thus, in setting times in this interference, I have taken into account decisions which need to be rendered in this case, as well as other cases. It is true that requests for extension of time are authorized by 37 CFR § 1.645. But, Rule 645 requires a showing of "good cause." Whatever counsel's experience may be in other PTO matters or courts generally, my standard of what constitutes "good cause" is considerably high.

There are few, if any, circumstances where "good cause" can be based on the press of other business arising after a time is set by an order entered in this interference, particularly where a time period is set after conference with counsel. Thus, a matter in another case (i.e., argument or a trial) or an event (i.e., a deposition; client meeting in the U.S. or abroad) scheduled or ordered after a conference call, in which a time is set in this interference, normally will not constitute the press of other business.

Generally, I do not consider an attempt to settle "good cause." While I encourage settlement, and am available to assist in settlement efforts where appropriate, it is my rather firm

policy--subject to few, if any, exceptions--that the parties can either settle or meet the next pending deadline.

Fred E. McKelvey

FRED E. MCKELVEY
Senior Administrative Patent Judge

Attachment
(37 CFR § 1.611(c))

The parties involved in this interference are:

Junior Party

Named inventors: John Felegi, Jr., Lancaster, Pennsylvania
Kenneth P. Kehrer, Lancaster, Pennsylvania

Application: Application 08/126,634,
filed September 27, 1993

Title: Composite fiberboard and process of
manufacture

Assignee: None

Attorneys: Herbert M. Wolfson, Esq.

Accorded Benefit: Application 07/275,914,
filed November 25, 1988

Address: Herbert M. Wolfson, Esq.
c/o ARMSTRONG WORLD INDUSTRIES, INC.
Patent Department
P. O. Box 3001
Lancaster, Pennsylvania 17604

For Federal Express:

Herbert M. Wolfson, Esq.
c/o ARMSTRONG WORLD INDUSTRIES, INC.
Patent Department
150 North Queen Street
Lancaster, Pennsylvania 17603

Senior Party

Named Inventors: Robert S. Beyersdorf, Midland, Michigan
William H. Keskey, Midland, Michigan

Patent: Patent N^o 4,863,979,
granted September 5, 1989,
reexamination certificate B1 4,863,979,
issued December 24, 1991

Title: Latex compositions useful as binders in
composite board having dimensional stability
and strength

Assignee: The Dow Chemical Company

Attorneys: Richard G. Waterman, Esq.

Accorded Benefit: Application 06/928,237,
filed November 7, 1986 (now abandoned)

Address: Richard G. Waterman, Esq.
THE DOW CHEMICAL COMPANY
P. O. Box 1967
Midland, Michigan 48641-1967

For Federal Express:

Richard G. Waterman, Esq.
The Dow Chemical Company
1790 Building
Midland, Michigan 48461

Count 1

The composite board of claim 1 of the Felegi et al.
application,

or

the composite board of claim 7 of the Felegi et al.
application,

or

the composite board of claim 9 of the Felegi et al.
application,

or

the composite board of claim 1 of the Beyersdorf patent, as
reexamined,

or

the composite board of claim 23 of the Beyersdorf patent, as
reexamined,

or

the composite board of claim 24 of the Beyersdorf patent, as
reexamined.

The claims of the parties which correspond to count 1 are:

Felegi: 1-3 and 7-9

Beyersdorf: 1-24

Appendix

Paper No. _____

Filed on behalf of: Party _____

By:

Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge Fred E. McKelvey)

JOHN FELEGI, Jr., and KENNETH P. KEHRER

Junior Party,

v.

ROBERT S. BEYERSDORF and WILLIAM H. KESKEY

Senior Party.

Patent Interference No. 103,626

TITLE OF PAPER

cc (via Federal Express):

Attorneys for Felegi:

Herbert M. Wolfson, Esq.
c/o ARMSTRONG WORLD INDUSTRIES, INC.
Patent Department
150 North Queen Street
Lancaster, Pennsylvania 17603

Attorneys for Beyersdorf:

Richard G. Waterman, Esq.
THE DOW CHEMICAL COMPANY
1790 Building
Midland, Michigan 48461

Enc. Sample Order relating to the filing of preliminary motions
(and related materials) and preliminary statements

Copies of specifications and claims of involved application
and patent

Copy of PTO Form 850, Rule 609(b) statement, and related
papers